

Applicanon No. 10/728,593
Amendment dated JANUARY 12, 2006
Reply to Office Action mailed October 13, 2005

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action dated October 13, 2005, regarding the above-referenced patent application. Claims 1, 2, 4-12, and 14-20 are pending in the application, with claims 19 and 20 withdrawn from consideration. Claims 1-4, 6-14 and 16-18 stand rejected by the Examiner. Applicants respectfully request favorable reconsideration.

Interview

Applicants thank the Examiner for the phone interview on December 6, 2005. The reasoning for combining the Rudolph and Scott et al. references and the resulting combination were discussed. That discussion is expanded upon in the following remarks and arguments.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 4 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

Rejection under §103(a)

Claims 1, 2, 6-12, and 16-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rudolph (US 2,809,002) in view of Scott et al. (US 4,784,396). Applicants respectfully traverse the rejection.

Independent claims 1, 11, 12, and 18 recite a hanger assembly and method involving a screw pre-disposed and captivated within an opening in a flange, where captivation is achieved by threading on the screw threadingly engaging the outer perimeter of the opening in the flange. Neither Rudolph nor Scott et al. appears to teach or suggest such elements. Rudolph teaches a hanger for electrical fixtures with a series of mounting holes 33, 39. Rudolph does not teach any specific mounting means, but Fig. 1 appears to show nails used to mount the hanger to supports 21, 22. Rudolph thus fails to teach or suggest each and every element of the claims.

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Scott et al. appears to teach a multi-element engine subassembly including a gasket with "a tubular like plastic retaining clip 25 that permits assembly of all of the parts together prior to attachment to the engine, in a reliable manner", where the clip has "a sleeve portion 30 that is of sufficient length to extend through aligned holes in the rail or flange 31 of the oil pan 16 and the reinforcing plate 20." See column 2, lines 57-59 and 63-66 and FIGS. 1-2. Scott et al. teach that "a slight misalignment of the oil pan with the gasket may cause the gasket to be moved laterally or to be stretched or for the bolts to be misaligned with the gasket holes in a way that would cause a tear in the gasket. This might ultimately lead to leakage, which would of course be undesirable." See column 2, lines 50-55. Scott et al. thus appear to be directed to using a gasket with a protruding sleeve for aligning multiple parts of an assembly.

Applicants submit that there is no motivation for one of ordinary skill in the art to look to Scott et al. for ways to modify the device of Rudolph because Rudolph teaches a single piece flange to be secured to a joist. Rudolph does not appear to involve aligning multiple parts of a subassembly. As such, there is no reason to modify Rudolph with a gasket having clips such as that taught by Scott et al. Further, Applicants submit that even if one were motivated to modify Rudolph with the teachings of Scott et al., one would not arrive at the instantly claimed hanger assembly. Combining the teachings of Rudolph and Scott et al. would appear to result in the hanger of Rudolph with an added gasket having protruding clips as taught by Scott et al. Such a combination lacks a screw pre-disposed and captivated with in an opening in a flange, wherein captivation is achieved by the screw being configured such that threading on the screw threadingly engages the outer perimeter of the opening, as is recited in independent claims 1, 11, 12, and 18. Thus, even if one were motivated to combine Rudolph and Scott et al., one would not arrive at the claimed invention. Rudolph and Scott et al. do not appear to teach or suggest each and every element of the independent claims 1, 11, 12, and 18, or the claims dependent thereon. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 5 and 15 are rejected as being unpatentable over Rudolph in view of Scott et al. and Lewis (US 4,666,055). The Examiner asserts that it would have been obvious to one skilled in the art to have provided the device set forth in a combination of Rudolph and Scott

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et al. with a securing material for the screw as shown by Lewis as an additional securing means. Applicants respectfully traverse the rejection. As stated above, there is no motivation for one of ordinary skill in the art to combine the teachings of Rudolph and Scott et al., and even if one were to make such a combination, one would not arrive at the invention of the independent claims. Lewis does not appear to teach what Rudolph and Scott et al. lack.

Additionally, there is no motivation for one of ordinary skill in the art to combine Lewis with Rudolph and Scott et al. As stated above, Rudolph is directed to a hanger with a single piece flange to be secured to a joist, while Scott et al. is directed to a gasket with protruding clips to aid in aligning a multi-piece assembly prior to fastening the pieces together. Lewis appears to teach adding a paper washer to the mounting screws in a wiring device to align and secure the screws. However, as Scott et al. appear to teach a gasket with protruding clips for aligning the fastening bolts, it is not clear what function would be provided by the paper washer of Lewis.

Applicants submit that one of ordinary skill in the art would have no motivation for combining the teachings of Rudolph, Scott et al. and Lewis. Additionally, even if one were to make such a combination, one would not arrive at the claimed invention. It appears that a combination of Rudolph, Scott et al. and Lewis would result in the hanger of Rudolph with the added gasket of Scott et al. and paper washer of Lewis. Such a combination does not appear to teach or suggest a hanger assembly including a flange having an opening and a screw pre-disposed and captivated within the opening, wherein captivation is achieved by the screw being configured such that threading on the screw threadingly engages the outer perimeter of the opening, as is recited in the claims. The combination of Rudolph, Scott et al., and Lewis thus does not appear to teach or suggest each and every element of the claims. Reconsideration and withdrawal of the rejection is respectfully requested.

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Conclusion

Reexamination and reconsideration are respectfully requested. It is submitted that the pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,
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By their attorney,

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